

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of.: Breitenbach, A. & Wolff, H.-M.
Serial No.: **10/630,633**
Filed: July 29, 2003
Title: HOT-MELT TTS FOR ADMINISTERING ROTIGOTINE
Group Art Unit: 1615
Examiner: S.T. Tran
Confirmation No.: 9056
Docket No.: **6102-000068/US**
Client Ref.: P/Br/I/5/02

SUBMITTED ELECTRONICALLY VIA EFS-WEB

July 20, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

RESPONSE AND AMENDMENT AFTER FINAL OFFICE ACTION
(INCLUDING PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. §1.136)
(INCLUDING STATEMENT OF SUBSTANCE OF INTERVIEW)

This paper, incorporating amendment and response to the Office Action dated March 19, 2009 in the above referenced application, which was made final, is submitted as follow-up to the letter dated May 18, 2009 requesting withdrawal of finality. If finality is withdrawn (as Applicant believes is warranted in this case for reasons set forth in the May 18, 2009 letter), consideration of the present amendment and response is respectfully requested. If withdrawal of finality is denied and the present response and amendment are not entered, Applicant may, at its option, file notice of appeal or request for continued examination within the statutory period for doing so.

Applicant hereby makes petition for extension of time of one (1) month in which to submit the present response and amendment. Authorization is provided herewith to charge the

fee required under 37 C.F.R. §1.17(a)(1) to Deposit Account No. 08-0750.

By amendment herein, excess claim fees are believed incurred for one (1) additional independent claim in excess of 3 and for six (6) total additional claims in excess of 20. Authorization is hereby given to charge such fees and any additional fees that may be found payable in respect of the present submission to Deposit Account No. 08-0750. However, Applicant believes that no fees will be due if withdrawal of finality is denied and the present response and amendment are not entered.

STATEMENT OF SUBSTANCE OF INTERVIEW

Applicant appreciates the Examiner's courtesy in granting a telephonic interview with Applicant's representatives William Ziehler and Leanne Rakers on May 15, 2009. However, the Interview Summary prepared by the Examiner in the above-referenced case and mailed on May 19, 2009 is not in complete accordance with the understanding of Applicant's representatives. Applicant respectfully notes as follows.

Applicant's representatives William Ziehler and Leanne Rakers believe that the Examiner's suggestion was not to submit a full response to the final rejection prior to a determination by the Office on the question of finality. Instead, these representatives understood (and have acted on this understanding) that the Examiner's suggestion was to submit in writing a request for withdrawal of finality; if such request were approved a new non-final action would be issued, and if denied, Applicant's recourse would be (within the statutory period for response to the March 19, 2009 Office Action) to file notice of appeal or request for continued examination.

As correctly recorded in the Examiner's Interview Summary, Applicant's representatives observed that a full response within the two-month period (*i.e.*, not later than May 19, 2009) would not be possible because of the time required for review in Germany.

Applicant's representative William Ziehler, subsequent to the interview, submitted a letter headed "Request for Withdrawal of Finality" on May 18, 2009. That request pointed out that the 35 U.S.C. §103 rejection maintained in the Action was based on mischaracterization of the pending claims, particularly with respect to melting the active ingredient. In particular, independent Claim 18, a method-to-make claim, expressly includes

melting components of the cement matrix, which include rotigotine. This is in direct contradistinction to the Action (p. 7, lines 1-2) which alleges that the method claims do not require melting the active agent.

AMENDMENT UNDER 37 C.F.R. §1.111 (AMENDMENT D)

Further examination of the above referenced application is requested following entry of the present amendment.

Amendments IN THE CLAIMS begin on page 4 of this paper.

REMARKS on the present amendment begin on page 8 of this paper.